

Remarks

Claims 1-49 are pending.

Claims 1-49 are subject to restriction and election of species requirement.

Claim 28 has been cancelled without prejudice.

Claims 1, 5, and 17 have been amended to correct the structural formula-to-text relationship. Additionally, Claims 29 and 32 have been amended to correct dependency. These corrections have been entered merely to correct computer program formatting informalities. No new matter has been entered as a result of this amendment.

Restriction Requirement

The Examiner has required restriction under 35 USC 121 to one of the two "inventions" identified as follows:

I - Claims 1-32, drawn to compounds and compositions, classified in "class 56", under various subclasses and an antimicrobial composition, classified in class 424 under various subclasses.

II - Claims 33-49, drawn to a method of reducing the presence of microorganisms on a substrate, classified in class 514, subclass 721.

The Examiner notes that inventions I and II are related as product and process of use. However, the Examiner contends that restriction is required and proper since "the process of using the product as claimed can be practiced with another materially different Product."

Applicants respectfully traverse this restriction requirement.

Applicants believe that the Examiner has made an arbitrary separation of the inventions based on multiple classification listings. A search of the specifically claimed phenol compounds would necessarily uncover and, therefore, include a search of all potential uses for such compounds, thus, imposing no additional searching burden on the PTO.

Furthermore, invention I and invention II disclose the *same* subject matter (i.e., phenols). Section 806.03 of the MPEP indicates that "[w]here the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required." Therefore, Applicants respectfully submit that the Examiner's restriction requirement under 35 USC §121 lacks support and is, therefore, improper.

Notwithstanding the aforementioned comments, should the restriction requirement be maintained, Applicants provisionally elect, with traverse, invention I.

Election of Species Requirement

The Examiner also contends that Claims 4, 16 and 32 are directed to patentably distinct species.

Applicants respectfully traverse this election of species requirement.

Claims 4, 16 and 32 are directed to phenol compounds having antimicrobial properties. Under 35 USC §121, the PTO has authority to restrict an application to a single disclosed species where the claims cover two or more "independent *and* distinct" species. The phenol compounds of present invention, however, fail to meet this requirement; they are *not* "independent" (i.e., they do not

lack commonality of design, operation or effect). All of the disclosed species are phenols and are directed to reducing or eliminating harmful microorganisms.

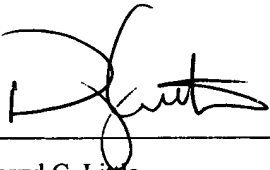
Furthermore, the Examiner provides no reason as to why the species *should be* considered independent and distinct. Regardless, Applicants believe that the Examiner has made an arbitrary separation of species based on a plurality of species without explanation. Moreover, a search of the invention should be the same regardless of the specific phenol compound elected, thus, imposing no serious searching burden on the PTO. Accordingly, Applicants respectfully submit that the Examiner's election of species requirement under 35 USC §121 is improper and respectfully request that the requirement be withdrawn.

Notwithstanding the aforementioned comments, should the election of species requirement be maintained, Applicants provisionally elect, with traverse, 2-(2-hydroxyphenoxy)-6-(2-hydroxycyclohexyl) phenol.

In view of the foregoing remarks, it is respectfully requested that the Examiner withdraw his requirement for an election of species and allow the generic claims to be prosecuted on the merits in the present application. In the event that the Examiner's restriction and/or election of species requirement is made final, Applicants affirm the provisional elections made above. Claims 1, 4-5, 7, 16, 19, 32, and 40 read on the elected species.

Respectfully submitted,

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